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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,044	01/26/2000	Gentaro Okayasu	450100-02278	9377
20999	7590	05/22/2006	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			HWANG, JOON H	
			ART UNIT	PAPER NUMBER
			2166	

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/492,044

Applicant(s)

OKAYASU ET AL.

Examiner

Joon H. Hwang

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The applicants amended claims 1, 5, and 9 in the amendment received on 3/1/06.

The claims 1, 3-5, and 7-10 are pending.

### ***Claim Objections***

2. Claims 7 and 9 are objected to because of the following informalities:
  - “the control means” in claim 7, line 4, should be “control means”; and
  - “the control means” in claim 9, line 2, should be “control means”.

Appropriate correction is required.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1 and 5 have been considered but are moot in view of the new ground(s) of rejection.

The applicants added in claims 1 and 5 the limitations of generating a stream with a unique identifier when a recording area is successfully secured. These limitations are addressed in the following rejection.

### ***Claim Rejections - 35 USC § 101***

4. Claims 1 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 (II)(A) states:

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The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claim 1 recites "determining whether there exists a recording means having an unused port" in line 10 and "wherein the control means generates a stream with a unique identifier when a recording area is successfully secured" in lines 11-12. The claim produces no concrete result. A generation of a stream with a unique identifier appears to be a result when there exists a recording means having an unused port; however, it is not clear that the generation is the result when there exists a recording means having an unused port. The claim also appears to have no claimed result under the condition where there doesn't exist a recording means having an unused port. Thus, claim 1 is non-statutory. The same rationale applies to claim 5. Furthermore, claim 5 produces no tangible result.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“that” in claim 1, line 3, is unclear and indefinite.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-5, and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fijita et al. (U.S. Patent No. 5,841,740) in view of Uchinuma (U.S. Patent No. 5,440,737), and further in view of Blumenau et al. (U.S. Patent No. 6,574,667).

With respect to claim 1, Fijita teaches a free storage space management in a broadcasting apparatus (i.e., updating free space information in audio/video data recording/reproducing apparatus, lines 50-58 in col. 9 and fig. 1). Fijita teaches recording means for recording that includes information relating to free storage space of the recording means (i.e., a hard disc array device for recording that includes free space information, fig. 1, fig. 3, fig. 4, fig. 7, lines 35-58 in col. 5, lines 20-42 in col. 6, lines 10-

37 in col. 7, lines 13-65 in col. 8, lines 50-58 in col. 9, and lines 53-56 in col. 10). Fijita teaches control means for recording information in the recording means and for acquiring the information relating to the free storage space of the recording means (i.e., a control system records information in the hard disc array device and generates free space information of the hard disc array device, fig. 1, fig. 2, lines 28-45 in col. 7, lines 50-58 in col. 9, lines 12-16 in col. 10, lines 14-21 in col. 12, line 40 in col. 13 thru line 23 in col. 14, and lines 60-63 in col. 20). Fijita teaches the control means generates a stream with a unique identifier when a recording area is successfully secured (i.e., secures recording regions for recording, generates record entry, and generates a file handle, line 40 in col. 13 thru line 24 in col. 14). Fijita does not explicitly disclose generating a list in which the recording means are arranged in decreasing order of free storage space. However, Uchinuma teaches generating a list in which the recording means are arranged in decreasing order of free storage space and the control means selects the recording means (i.e., allocating volumes in decreasing order of free space available and a file-allocation control selects a suitable volume, line 41 in col. 5 thru line 53 in col. 6 and fig. 3) in order to provide the highest data processing efficiency. Uchinuma further teaches comparing the storage space consumption amount to the free storage space values of all the recording means (i.e., checking whether there is enough free space on all the volumes, line 41 in col. 5 thru line 37 in col. 6). Therefore, based on Fijita in view of Uchinuma, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Uchinuma to the system of Fijita in order to provide the highest data processing efficiency. Fijita teaches

an interface to a recording system in fig. 2. Fijita and Uchinuma do not explicitly disclose determining whether there exists a recording means having an unused port. However, Blumenau teaches determining whether there exists a recording means having an unused port (i.e., checking a non-busy storage port to a storage, wherein the storage coupled to a plurality of storage ports, line 48 in col. 5 thru line 5 in col. 6, lines 25-39 in col. 6, lines 20-55 in col. 8, and lines 17-28 in col. 9) in order to provide immediate access to the storage. Therefore, based on Fijita in view of Uchinuma, and further in view of Blumenau, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Blumenau to the system of Fijita in order to provide immediate access to the storage.

With respect to claim 3, Fijita teaches when a discrepancy occurs between the information relating to the free storage space of the recording means and management information relating to free storage space in the control means, the control means synchronizes the management information relating to free storage space in the control means with the information relating to the free storage space of the recording means (i.e., generating free space information in a volatile memory (RAM) of a control system, wherein the generation is based on information from other apparatuses, such as the hard disc array device, than the RAM of the control system, and updated free space information is maintained on both the control system and the hard disc array device, fig. 1, fig. 2, lines 10-45 in col. 7, lines 50-58 in col. 9, lines 12-16 in col. 10, lines 14-21 in col. 12, line 40 in col. 13 thru line 23 in col. 14, and lines 60-63 in col. 20).

With respect to claim 4, Fijita teaches the recording means includes a plurality of recording means and an operation of securing a recording area in one of the plurality of recording means in response to a command from the control means (i.e., a plurality of hard disc devices, lines 55-65 in col. 8, lines 54-56 in col. 13, and lines 39-48 in col. 20). Fijita does not explicitly disclose securing a recording area in another of the plurality of recording means in accordance with a reason for a failure of the securing. However, Uchinuma teaches securing a recording area in another of the plurality of recording means in accordance with a reason for a failure of the securing (i.e., locating a recording area in another of the plurality of storage volumes based on a failure of locating one, line 41 in col. 5 thru line 37 in col. 6 and fig. 3). Therefore, the limitations of claim 4 are rejected in the analysis of claims 1 and 3 above, and the claim is rejected on that basis.

The limitations of claim 5 are rejected in the analysis of claim 1 above, and the claim is rejected on that basis.

The limitations of claim 7 are rejected in the analysis of claim 3 above, and the claim is rejected on that basis.

The limitations of claim 8 are rejected in the analysis of claim 4 above, and the claim is rejected on that basis.

9. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fijita et al. (U.S. Patent No. 5,841,740) in view of Uchinuma (U.S. Patent No.



5,440,737) and Blumenau et al. (U.S. Patent No. 6,574,667), and further in view of Schmuck et al. (U.S. Patent No. 6,032,216).

With respect to claim 9, Fijita, Uchinuma, and Blumenau disclose the claimed subject matter as discussed above except temporarily securing a recording area in the second information relating to free storage space but does not change a value of the information relating to the free storage space of the recording means. However, Schmuck teaches temporarily securing a recording area in the second information relating to free storage space but does not change a value of the information relating to the free storage space of the recording means (i.e., obtaining a token for temporarily securing free spaces in a region and updating a status of an allocation table as "in use" for the free spaces in the region; thus, a value of the information relating to the free space is not changed, line 37 in col. 17 thru line 24 in col. 18, lines 20-29 in col. 14, and lines 19-54 in col. 15) in order to reduce interferences among multiple processors simultaneously allocating storage spaces. Therefore, based on Fijita in view of Uchinuma and Blumenau, and further in view of Schmuck, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching of Schmuck to the system of Fijita in order to reduce interferences among the multiple processors simultaneously allocating storage spaces.

With respect to claim 10, the limitations of claim 10 are similar to the limitations of claim 7 above. Fijita, Uchinuma, and Blumenau do not explicitly disclose synchronizing the second information relating to free storage space with the information relating to the free storage space of the recording means. However, Schmuck teaches maintaining

same status information for free spaces in a region on both the allocation table and disk when there is a change, such as consuming disk block, in the disk (lines 20-29 in col. 14, lines 7-54 in col. 15, and line 37 in col. 17 thru line 57 in col. 18) concerning synchronizing the second information relating to free storage space with the information relating to the free storage space of the recording means. Therefore, the limitations of claim 10 are rejected in the analysis of claims 7 and 9 above, and the claim is rejected on that basis.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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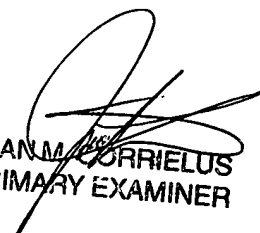
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joon H. Hwang whose telephone number is 571-272-4036. The examiner can normally be reached on 9:30-6:00(M~F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joon Hwang  
Patent Examiner  
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5/12/06

  
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PRIMARY EXAMINER